

Attorney Docket No. LWEP:125US
U.S. Patent Application No. 10/711,188
Reply to Office Action of September 29, 2006
Date: November 27, 2006

Remarks/Arguments

Allowable Subject Matter

The Examiner has indicated that Claims 20-27 are allowed. Applicants have added new Claims 28-30, which depend either directly or indirectly from Claim 20. Thus, as Claim 20 is allowed, it generally follows that new Claims 28-30 are also allowed due to their dependency therefrom. Applicants respectfully request allowance of new Claims 28-30, which action is appropriate.

Objection to Claims 5-12

The Examiner has objected to Claims 5-12 as being dependent upon a rejected base claim, but the Examiner has indicated that Claims 5-12 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have amended Claim 5 to include all the limitations of its base claim, *i.e.*, Claim 1, and there are no other intervening claims. Hence, Claim 5 and all claims dependent therefrom, *i.e.*, Claims 6-12 are now in condition for allowance, which action is courteously requested.

Rejection of Claims 1-4 and 16-19 Under 35 U.S.C. § 102(b)

The Examiner has rejected Claims 1-4 and 16-19 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,482,221 (*Clark*). Applicants respectfully traverse this rejection based on the following reasons.

“A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference.” *Vandergaal Bros. v. Union Oil of California*, 814 F.2d 628, 631; 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). In other words, the elements must be arranged as required by the claim, but this is

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not an *ipsissimis verbis* test, *i.e.*, identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

Applicants courteously submit that amended Claim 1 recites an arrangement that is not taught in *Clark*. More specifically, *Clark* does not teach a focusing device having first and second ends that is “displaceable in terms of its position within the microscope stand in such a way that **resultant displacements of said first and second ends are substantially equal**,” as taught in Applicants’ amended Claim 1. Although *Clark* may teach a focusing device having first and second ends, any displacement of a first end can not yield a substantially equal displacement of a second end, nor vice versa. For example, as lever 104 is actuated up and down, a first end moves up and down while a second end acts as a pivot point thereby preventing displacement of a first end equal to displacement of a second end. Similarly, fine shaft 26 and coarse shaft 30 both can not be displaced within conical bore 108 in such a fashion as to effect substantially equal displacement of respective first and second ends of fine shaft 26 and coarse shaft 30.

Hence, as Applicants’ amended Claim 1 contains an arrangement of elements not taught in *Clark*, it generally follows that *Clark* does not anticipate Applicants’ amended Claim 1. In like fashion, as Claims 2-4 and 16-19 contain all the limitations of the claims from which they depend, *i.e.*, Claim 1, it follows that Claims 2-4 and 16-19 are also not anticipated by *Clark*.

Furthermore, as *Clark* does not teach, suggest or motivate one to include the arrangement of elements as recited in Applicants’ Claim 1, it follows that Claim 1 is nonobvious in view of *Clark*. Again, due to their dependency from Claim 1, Claims 2-4 and 16-19 are also nonobvious in view of *Clark*.

Therefore, in view of the foregoing, Applicants respectfully assert that Claims 1-4 and 16-19, as amended, are in condition for allowance, which action is courteously requested.

Attorney Docket No. LWEP:125US
U.S. Patent Application No. 10/711,188
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Rejection of Claims 13-15 Under 35 U.S.C. § 103

The Examiner has rejected Claims 13-15 under 35 U.S.C. § 103 as being unpatentable over *Clark* in view of German Patent No. DE 3607379 (*Franz*). Applicants respectfully traverse this rejection for all the reasons recited above and based on the following reasons.

To establish a *prima facie* case of obviousness, the prior art reference, or references when combined, must teach or suggest all the claim limitations of the rejected claims. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

As described above, *Clark* fails to teach, suggest or motivate an arrangement of elements as taught in Applicants' amended Claim 1. Similarly, *Franz* fails to cure the defects of *Clark*, *i.e.*, fails to disclose an arrangement of elements as taught in Applicants' amended Claim 1. Therefore, Applicants respectfully assert that as the arrangement of elements of amended Claim 1 is not taught by *Clark* and/or *Franz*, it generally follows that Claim 1 is patentable over *Clark* in view of *Franz*. Similarly, as Claims 13-15 contain all the limitations of Claim 1, due to their dependency therefrom, it follows that Claims 13-15 are also patentable over *Clark* in view *Franz* due to the lack of teaching of the arrangement of elements.

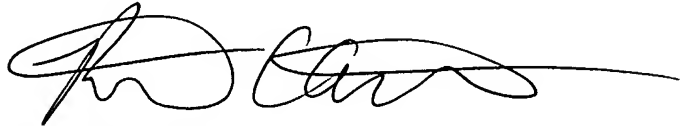
Therefore, in view of the foregoing, Applicants respectfully assert that Claims 13-15 are in condition for allowance, which action is courteously requested.

Attorney Docket No. LWEP:125US
U.S. Patent Application No. 10/711,188
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Conclusion

Applicants respectfully submit that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned agent of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. C. Atkinson', with a long horizontal flourish extending to the right.

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